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Accordingly, applicants have added new Claims 18 to 27 to further bring out some of the subsidiary embodiments of the method defined in Claim 1 which are addressed on page 3, indicated line 6 to page 4, indicated line 20, of the application. New Claims 28 to 37 and new Claims 38 to 47, depend upon Claims 15 and 16, respectively, and otherwise correspond to Claims 18 to 27. No new matter has been added.

The Examiner rejected Claims 1, 10, 13, 14, 16 and 17 under 35 U.S.C. §102(e) as being anticipated by the teaching of *Treacy et al.* (US 6,342,518), and Claims 1, 10 and 13 to 17 under 35 U.S.C. §103(a) as being unpatentable in light of the teachings of *Treacy et al.* (*ibid.*) and *Takagi et al.* (US 5,543,573).

It is respectfully urged that anticipation under Section 102 can be found only if a reference shows exactly what is claimed.²⁾ The fact that claimed subject matter may be encompassed by a generic disclosure does not by itself establish obviousness of the claimed subject matter,³⁾ and anticipation is the ultimate or epitome of obviousness.⁴⁾ Anticipation under Section 102 requires therefore more than a generic disclosure which encompasses claimed subject matter. The test for anticipation is one of identity which means that the identical invention must be shown in the reference in as complete detail as is contained in the claim.⁵⁾ In fact, the Federal Circuit has stated that it is error to treat claims as a catalog of separate parts, in disregard of the part-to-part relationships set forth in the claims that give those claims their meaning.⁶⁾

In light of the explanations and guidelines developed by the Courts, the teaching of *Treacy et al.* clearly falls short from establishing that the methods defined in applicants' claims are anticipated.

- 2) Cf. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985); *In re Marshall* 577 F.2d 301, 198 USPQ 344 (CCPA 1978); *In re Kalm* 378 F.2d 959, 154 USPQ 10 (CCPA 1967).
- 3) Cf. *In re Baird*, 16 F.3d 380, 29 USPQ2d 1550 (Fed. Cir. 1994); see also *Corning Glass Works v. Sumitomo Electric U.S.A.*, 868 F.2d 1251, 9 USPQ2d 1962 (Fed. Cir. 1989), which holds that a genus does not inherently disclose all species; and *In re Jones*, 958 F.3d 347, 21 USPQ2d 1614 (Fed. Cir. 1992), which holds that a genus does not render all species that happen to fall within the genus obvious.
- 4) Cf. *In re Grose*, 592 F.2d 1161, 201 USPQ 57 (CCPA 1979).
- 5) Cf. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989).
- 6) Cf. *Lindemann Maschinenfabrik v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

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The teaching of Treacy et al. addresses an insecticidal composition⁷⁾ which comprises synergistically effective amounts of

- (a) a neuronal sodium channel antagonist which *inter alia* encompasses compounds as represented by applicants' formula (I-1), and
- (b) an arylpyrrole,

and Treacy et al. provide that the composition is effective against a wide variety of lepidopteran and coleopteran insects such as cotton bollworm, tobacco budworm, potato beetle and corn rootworm and the like.⁸⁾ Additionally, Treacy et al. merely mention that⁹⁾

... the composition ... may be useful in the prevention and control of public health pests such as houseflies, mosquitos, cockroaches, ants, termites or the like.

Accordingly, Treacy et al. merely contemplate the possibility that the synergistic binary composition itself "may be" useful to control cockroaches, ants, termites or the like. The respective remarks are clearly unsuited to exactly show

- (a) a method for controlling a pest selected from the Isoptera, Hymenoptera, Orthoptera and Psocoptera orders which comprises applying to said pest or to a wooden part or to soil in the habitat of said pest an effective amount of a certain hydrazine compound as is represented by applicants' formula (I-1) which specifically requires for Y being 1 to 5 of the same or different substituents selected from the group consisting of nitro and cyano;¹⁰⁾ or
- (b) a method for controlling a pest from the Formicidae family in crops, which comprises applying an effective amount of a certain hydrazine compound as is represented by applicants' formula (I-1) which specifically requires for Y being 1 to 5 of the same or different substituents selected from the group consisting of nitro and cyano, to said pest, to said crops, to soil surrounding said crops or to a nest of said pest.¹¹⁾

As such, the teaching of Treacy et al. cannot reasonably be regarded as showing the identical invention in as complete detail as is con-

7) Cf. col. 1, indicated lines 61 to 67, of US 6,342,518.

8) Cf. col. 7, indicated lines 26 to 31, of US 6,342,518.

9) Cf. col. 7, indicated lines 32 to 35, of US 6,342,518, emphasis added.

10) Cf. applicants' Claims 1, 10, 13 and 14. Cf. also applicants' new Claims 18 to 27 which depend upon Claim 1.

11) Cf. applicants' Claims 16 and 17. Cf. also applicants' new Claims 38 to 47 which depend upon Claim 16.

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tained in applicants' claims. It is therefore respectfully urged that the rejection of Claims 1, 10, 13, 14, 16 and 17 under 35 U.S.C. §102(e) based on the teaching of Treacy et al. be withdrawn.¹²⁾

It is further respectfully urged that the rejection of Claims 1, 10 and 13 to 17 under Section 103(a) based on the teachings of Treacy et al. be withdrawn. Effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. 103 via 35 U.S.C. 102(e) was disqualified as prior art against the claimed invention if that subject matter and the claimed invention "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." Accordingly

Applicants, by undersigned attorney, hereby state that, at the time the invention disclosed and claimed in application Serial No. 10/019,481 was made, the invention was subject to an obligation of assignment to, and US 6,342,518 was owned by, the same party.

Favorable action is solicited.

Moreover, applicants' herewith present a Declaration of Dr. Oloumi-Sadeghi which inter alia addresses the teaching of Takagi et al. and sets forth data showing the unexpected improved effectivity of a representative of applicants' compounds (I-1) in the methods defined in applicants' claims. It should be noted on the one hand that Dr. Oloumi-Sadeghi specifically selected compound A007 of Takagi et al. since the respective compound, on the one hand, only differed from the compounds represented by applicants' formula (I-1) in the nature of the moiety Y. On the other hand, compound A007 of Takagi et al. is among the compounds which are taught by the reference to cause 100% mortality in each of the described investigations. However, when the compound of Takagi et al. was applied against pests such as referenced in applicants' claims, no or only insufficient control was achieved whereas the representative of applicants' formula (I-1) achieved 85 to 100% mortality at similar application rates.¹³⁾

The results reported in Dr. Oloumi-Sadeghi's Declaration corroborate that compounds which meet the particular structural requirements of applicants' formula (I-1) are exceptionally better suited to con-

12) Cf. also applicants' remarks on pages 5 and 6 of the paper dated December 13, 2004, and applicants' remarks on pages 6 and 7 of the paper dated September 27, 2005.

13) Cf. in particular the data addressed on pages 6 to 9, of Dr. Oloumi-Sadeghi's declaration.

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trol the pests enumerated in applicants' claims than compounds which are illustrative of *Takagi et al.*'s teaching.

The Examiner argued that it would be obvious to vary the form of each ingredient to optimize the desired effect, depending upon the particular pest of interest, reduction of toxicity, cost, minimization, enhanced, and prolonged, or synergistic effects, with consideration of pesticide ingredient compatibility.¹⁴⁾ A particular parameter must first be recognized as a result-effective variable, ie., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation and the variation of the respective variable in the manner necessary to arrive at the claimed invention can be regarded as being *prima facie* obvious.¹⁵⁾ The teaching of *Takagi et al.* does not contain any information which would allow a determination which of the various radicals in the compounds represented by *Takagi et al.*'s formula (I) is result effective, and/or which of the radicals would need to be modified in order to arrive at a compound or compounds which are particularly suited to control certain pests. A person of ordinary skill who contemplated the teaching of *Takagi et al.* therefore had to vary all of the variable moieties and all pests. As such, the teaching of *Takagi et al.*, at best, issued an invitation to experiment rather than guiding to the particularities which characterize applicants' methods. "Obvious to try" is, however, not a proper basis for finding that a claimed invention is unpatentable under Section 103(a).¹⁶⁾ In light of the foregoing and the attached it is therefore respectfully urged that applicants' methods were nor rendered *prima facie* obvious within the meaning of Section 103(a) at the time applicants made their invention. Favorable reconsideration of the Examiner's position and withdrawal of the respective rejection is respectfully solicited.

14) Cf. page 3, line 17, to page 4, line 2, of the Office action.

15) Cf. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977); *Merck & Co. Inc. v. Biocraft Laboratories Inc.*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989); *In re Kulling*, 897 F.2d 1147, 14 USPQ2d 1056 (Fed. Cir. 1990); and *In re Geisler*, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997).

16) Cf. *Merck & Co. Inc. v. Biocraft Laboratories Inc.*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir. 1989) where the Court held that an invention was merely "obvious to try" if the prior art gives either no indication of which parameters are critical or no direction as to which of the many possible choices is likely to be successful. See also the cases cited in *In re O'Farrell*, 853 F.2d 894, 7 USPQ2d 1673 (Fed. Cir. 1988) for examples of decisions where the court discussed an improper "obvious to try" approach.

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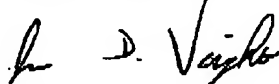
REQUEST FOR EXTENSION OF TIME:

It is respectfully requested that a two month extension of time be granted in this case. The respective \$450.00 fee is paid by credit card (Form PTO-2038 enclosed).

Please charge any shortage in fees due in connection with the filing of this paper, including Extension of Time fees, to Deposit Account No. 14.1437. Please credit any excess fees to such deposit account.

Respectfully submitted,

NOVAK DRUCE DELUCA & QUIGG



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Encl.: CLAIM AMENDMENTS (Appendix I)

Dr. Oloumi-Sadeghi's Declaration dated March 08, 2006

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